



## UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/777,514	02/11/2004	Kerry Zang	073275.0163	5263
5073	7590	02/08/2010		
BAKER BOTTS L.L.P. 2001 ROSS AVENUE SUITE 600 DALLAS, TX 75201-2980			EXAMINER MILLER, CHERYL L	
			ART UNIT 3738	PAPER NUMBER
			NOTIFICATION DATE 02/08/2010	DELIVERY MODE ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ptomail1@bakerbotts.com  
glenda.orrantia@bakerbotts.com

**Advisory Action  
Before the Filing of an Appeal Brief**

**Application No.**

10/777,514

**Applicant(s)**

ZANG ET AL.

**Examiner**

CHERYL MILLER

**Art Unit**

3738

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 04 January 2010 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.  
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.  
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ They raise the issue of new matter (see NOTE below);  
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
The status of the claim(s) is (or will be) as follows:  
Claim(s) allowed: \_\_\_\_\_.  
Claim(s) objected to: \_\_\_\_\_.  
Claim(s) rejected: \_\_\_\_\_.  
Claim(s) withdrawn from consideration: \_\_\_\_\_.

**AFFIDAVIT OR OTHER EVIDENCE**

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
See Continuation Sheet.

12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). \_\_\_\_\_  
13. ☐ Other: \_\_\_\_\_.

/Corrine M McDermott/  
Supervisory Patent Examiner, Art Unit 3738

/Cheryl Miller/  
Examiner, Art Unit 3738

Continuation of 11. does NOT place the application in condition for allowance because: The applicant has argued they have support for "substantially constant" in the original claims (noting that figs. 1a, 1b show tapered threads and original claims support substantially constant, thus applicants have support for both tapered and constant threads). The examiner disagrees. The applicant specification with regards to fig. 1a, 1b, does not disclose the threads 54 to be tapered or constant. The specification just discloses that a thread 54 is present (thread being singular) and discloses possible dimensions for the thread (pg. 10). The applicant does not have support for tapered AND constant threads. Only one embodiment is shown/disclosed with regards to figs. 1a, 1b. A thread height of approximately .032 inches is disclosed. Thus since one thread height with one dimension is disclosed with regards to fig. 1a, 1b, applicants only have support for a constant thread. As only one thread height is disclosed with regards to fig. 1a, 1b, we must assume the figures intend to show a constant thread height and that the figures are not to scale (figs seem to show a slight taper, however spec discloses otherwise). Thus, "substantially" constant is believed by the examiner to not be supported (only constant is), and by allowing "substantially" constant into the claims, this broadens applicants original coverage to tapers as shown in applicants not to scale drawings.

The applicant has argued that Simon et al. (US 5,951,560) does not disclose a "substantially constant" thread height. It is the examiners opinion that if figures 1a and 1b of applicants specification may be considered "substantially constant", than Simon's threads seem equally as "substantially constant" in height. That is a very minimal taper angle leaves threads that are of "substantially constant" thread height.

The applicant argues that Rosan (US 3,726,180) does not disclose a "substantially constant thread height" and that Rosan discloses the threads to uniformly reduce their diameter, thus taper. The examiner disagrees. Thread 12 at top of implant has a constant thread height; over region 12a, the outside diameter of implant (at thread crest) reduced/tapers-just as the inner diameter (thread root) is reduced, thus the overall thread height (crest-root) stays constant. See fig. 1, col. 2, lines 4-23, "thread forms of forming threads 12a are uniform and are also similar to the thread forms of the other thread convolutions 12". It is noted that the taper angle (outside surface of crest) is not required by the claim to be constant, only the thread height is required to be constant (crest-root distance). It is also noted that the claims require the tapered circumference to taper from the first diameter to the second diameter (not from the first end to the second end). If applicant were to claim the taper to extend from the first end to the second end, this would seemingly overcome Rosan.

The applicant has argued that Parlov (US 7,608,105) and Visotsky (US 2002/0038123) do not disclose a "substantially constant" thread height. The examiner disagrees. The claim requires "at least one continuous thread" to have a substantially constant thread height. Thus each single turn (distance between two slots 54 of Parlov and distance between 50's of Visotsky) may be considered one thread, thus Parlov and Visotsky's implants comprising a plurality of threads (each turn, each one being uninterrupted). The plurality of threads are considered the "at least one thread". Each individual thread (single turn between 52's or between 50's) has a substantially constant thread height. The grouping/plurality of threads (at least one threads) spans the full length of the implant. The claims do not require a single continuous uninterrupted thread from one end to another, the claims instead require at least one (thus possibly a plurality) continuous uninterrupted thread (each one of the plurality being uninterrupted) spanning from one end to the other (grouping of threads spans entire length). If applicant were to claim A continuous uninterrupted thread...this would seemingly overcome Parlov and Visotsky. In fact, it is suggested applicant claim this, since "at least one" continuous thread (thus possibly multiple), each from one end to the other of the implant does not seem to be supported by applicants figures. Figures 1a, 1b only show one continuous uninterrupted thread extending from the first end to the second end (not a plurality-at least one).